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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,090	06/20/2001	Yasuo Matsumura	109890	2361

7590 05/20/2004  
Oliff & Berridge PLC  
P.O. Box 19928  
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EXAMINER

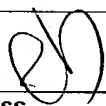
NOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/884,090	MATSUMURA ET AL.	
	Examiner	Art Unit	
	Janis L. Dole	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 7-12 and 14-20 is/are allowed.
- 6) ☒ Claim(s) 5, 6 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/7/03</u> . | 6) <input type="checkbox"/> Other: _____  |

1. This office action is responsive to applicants' remarks filed on Jul. 23, 2003, and to the Rule 132 declaration, executed by Yasuo Matsumura on May 22, 2003, filed on May 27, 2003. (The Rule 132 declaration filed on Jul. 23, 2003, is a copy of the one filed on May 27, 2003. Applicants' remarks filed on May 27, 2003, are substantially identical to those filed on Jul. 23, 2003.) Claims 1-20 are pending.

2. The amendment to the specification filed on Feb. 25, 2004 (Amdt022504), is considered to be non-compliant with 37 CFR 1.121, for the reasons discussed in the prior notice of non-compliant amendment mailed on Oct. 14, 2003, and in the notice of non-responsive amendment mailed on Jul. 1, 2003. The amendment to the paragraph beginning at page 5, line 19, of the specification, filed on Feb. 25, 2004, tries to amend a paragraph that is not present in the instant specification. The amendment filed on Feb. 25, 2004, tries to amend the originally filed paragraph, not the amended paragraph that was previously filed on Dec. 12, 2002.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph" (emphasis added).

(Three notices of non-compliant amendment have already been mailed to applicants.) Accordingly, the amendment to the specification filed on Feb. 25, 2004, has not been entered.

The amendment to the specification filed on May 27, 2003 (Admt052703), was held to be non-responsive for the reasons discussed in the notice of non-responsive amendment mailed on Jul. 1, 2003. The amendments to the specification filed on Jul. 23, 2003 (Amdt072303), and Oct. 23, 2003 (Amdt102330), were considered to be non-compliant with 37 C.F.R. 1.121 for the reasons set forth in the notices of non-compliant amendments mailed on Oct. 14, 2003, and Jan. 29, 2004, respectively. These three amendments to the specification were not entered.

3. The rejections of claims 1-6 and 8-14 under 35 U.S.C. 102(b)/103(a) over US 6,002,662 (Matsumura'662), of claims 1-14 under 35 U.S.C. 102(b)/103(a) over US 5,910,389 (Matsumura'389), and of claims 1-6 and 8-14 under 35 U.S.C. 102(e)/103(a) and 35 U.S.C. 102(a)/103(a) over US 6,153,346 (Machata), set forth in the office action mailed on Feb. 26, 2003 (CTNF022603), paragraphs 13-15, respectively, have been withdrawn in response to the showings in the Rule 132 declaration executed by Yasuo Matsumura on May 22, 2003, filed on May 27, 2003 (AF/D052703). The declaration shows that the toners in example 1 of

Matsumura'662, in example 3 of Matsumura'389, and in example 2 of Machata, do not have surface protrusions of releasing agent having a height of "approximately 0.05  $\mu\text{m}$  to 2  $\mu\text{m}$ ," as recited in instant claims 1 and 12. Accordingly, applicants have met their burden to show that toners disclosed in the cited prior art do not meet all the limitations recited in the instant claims. Moreover, none of the cited prior art describes or suggests toners comprising such surface protrusions as recited in the instant claims.

4. For the reasons discussed in paragraph 3, supra, claims 1 and 12 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 15-20, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, have been rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the office action mailed on Sep. 13, 2002, is hereby withdrawn.

5. The amendment to the specification filed on Dec. 12, 2002, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The replacement paragraph beginning at page 5, line 19, of the specification, states that the parameter "n represents a [sic: the] number of particles in a channel of a particle size analyzing apparatus that uses the Coulter principle, such as a Coulter Counter" (emphasis added). The originally filed specification does not provide antecedent basis for said amended definition of parameter n. The originally filed specification at page 6, line 1, defines the parameter "n as representing the number of particles in a channel of a Coulter Counter." COULTER COUNTER is a trademark. See the TESS search report, serial no. 72062272. There is no evidence on the present record showing that the originally disclosed COULTER COUNTER is a "particle size analyzing apparatus that uses the Coulter principle" as now disclosed in the replacement paragraph. Nor is there anything in the record indicating that "the Coulter principle" is a term of art, the meaning of which is known to those skilled in the art.

Applicants are required to cancel the new matter in the reply to this Office Action.

Applicant's arguments filed on Jul. 23, 2003, have been fully considered but they are not persuasive.

Applicants assert that the term "COULTER COUNTER" is a generic term for "a particle size analyzing apparatus," relying on the disclosure in US 5,910,389, col. 6, lines 11-24, for support. Applicants further assert that the term "Coulter Principle" is well known in the art. Applicants rely on the disclosure in US 4,826,747 (Chiba), col. 5, lines 35-42, as evidence that the term "Coulter principle" is known in the art.

However, applicants' evidence is insufficient to support applicants' assertions. The term "COULTER COUNTER," on the present record, is not a "generic term for a particle size analyzing apparatus that can be used to measure the average particle size of resin particles" as asserted by applicants. The disclosure in US 5,910,389 states that the "average diameter can be measured with, for example, a Coulter counter." COULTER COUNTER is the name of an apparatus. Matsumura'662 at col. 4, lines 40-43, discloses that particular size distributions can be "measured by use of an instrument such as Coulter Counter II (manufactured by Nikkaki Co., Ltd) or Multisizer II (manufactured by Nikkaki Co., Ltd)." Furthermore, as disclosed

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in US 6,248,494 B1, the average particle size of a toner may also be measured employing a SLAD1100, a laser diffraction particle size analyzer manufactured by Shimadzu Mfg., Co., LTD., in addition to a COULTER COUNTER TA-II and a COULTER MULTISIZER. US 6,248,494 B1, col. 5, line 64, to col. 6, line 2.

In addition, Chiba does not establish that the term "Coulter principle" has a well known definition in the art. Chiba at col. 5, lines 35-42, merely discloses that the "particle size distributions of toner particles . . . can be measured by a Coulter counter . . . based on the electric resistance method called 'Coulter Principle', using an aperture tube having a diameter of 100  $\mu\text{m}$  for the toner particles." However, US 5,698,354 at col. 17, line 66, to col. 18, line 2, discloses that the number-based particle size distribution of a toner can be "measured by . . . Coulter Counter TA-II with a 100  $\mu$  aperture or a 50  $\mu$  aperture in the range of from 2 to 40  $\mu$  (1 to 20  $\mu$ ).". There is no disclosure in the instant specification showing that the originally disclosed COULTER COUNTER is a "particle size analyzing apparatus that uses the Coulter principle" using an aperture tube having a diameter of 100  $\mu\text{m}$ , as defined by Chiba.

Accordingly, the objection stands.



6. The disclosure is objected to because of the following informalities:

The use of trademarks, e.g. Coulter Counter [sic: COULTER COUNTER] in the replacement paragraph at page 5, line 19, of the specification, filed on Dec. 12, 2002, has been noted in this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. This example is not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Applicants' arguments filed on Jul. 23, 2003, have been fully considered but they are not persuasive. Applicants assert that the specification has been amended to overcome the objection. However, for the reasons discussed in paragraph 2, supra, none of the amendments to the specification filed on May 27, 2003, Jul. 23, 2003, Oct. 23, 2003, and Feb. 25, 2004, have been entered. Accordingly, the objection stands.

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7. The examiner notes that the surface property index recited in instant claim 13 is defined in the instant specification in the replacement paragraph beginning at page 5, line 19, of the specification, filed in Paper No. 10 on Dec. 12, 2002. The index GSDv recited in instant claim 14 is defined in the instant specification at page 6, lines 16-18.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 6, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 6 are indefinite because the parameters "n" and "R" defined as representing "a number of particles in a channel" and "a channel particle diameter" in "a particle size analyzing apparatus, which utilizes the Coulter principle." It is not clear what is meant by the phrase "utilizes the Coulter principle." The originally filed specification does not define

the "Coulter principle." Rather, the originally filed specification merely discloses the use of a COULTER COUNTER. See the originally filed specification at page 6, lines 1-3.

Claim 13 is indefinite because the surface property index is determined by the trademark COULTER COUNTER. See the instant specification, the replacement paragraph at page 5, line 19, of the specification, filed in Paper No. 10 on Dec. 12, 2002. The same trademark can be used to identify different apparatuses or products depending on the desire of the owner. The apparatus associated with the trademark at the time the invention was made may not be the same as the apparatus at a later date, and may not be the same apparatus as in the past. The trademark does not refer to a definite apparatus. Thus, the claim is indefinite.

Claim 13 is further indefinite because the replacement paragraph at page 5, line 19, further discloses that the parameter "n represents a [sic: the] number of particles in a channel of a particle size analyzing apparatus that uses the Coulter principle, such as a Coulter Counter" (emphasis added) for the reasons discussed with respect to claim 5.

Applicants' arguments filed in Jul. 23, 2003, have been fully considered but they are not persuasive.

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Applicants assert that "one skilled in the art would know, at least from the disclosure of Chiba, the meanings of the terms 'Coulter Counter' and 'Coulter Principle' and that a 'Coulter counter is a particle size analyzing apparatus using the Coulter Principle.'" "

However, for the reasons discussed in paragraph 5, applicants' arguments are not persuasive, and the rejections stand.

10. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 5, 6, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 5 and 6 recite that the parameters "n" and "R" are defined as representing "a number of particles in a channel" and "a channel particle diameter" in "a particle size analyzing apparatus, which utilizes the Coulter principle."

In claim 13, the surface property index is determined by the parameter "n" which "represents a number of particles in a channel of a particle size analyzing apparatus that uses the Coulter principle, such as a Coulter Counter" (emphasis added).

The originally filed specification does not provide an adequate written description of the parameters "n" and "R" as recited in instant claims 5, 6, and 13. The originally filed specification at page 6, line 1, defines the parameter "n" as representing "a number of particles in a channel of a Coulter Counter." The originally filed specification at page 6, lines 1-12, defines the parameter "R" as representing "a channel particle diameter in the Coulter Counter." COULTER COUNTER is a trademark. See the TESS search report, serial no. 72062272. There is no evidence on the present record showing that the originally disclosed COULTER COUNTER is a "particle size analyzing apparatus" that utilizes the "Coulter principle" as now recited in the instant claims and in the replacement paragraph beginning at page 5, line 19, of the specification, filed on Dec. 12, 2002. Nor is there anything in the record

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indicating that "the Coulter principle" is a term of art, the meaning of which is known to those skilled in the art.

Applicants did not specifically address the rejection in their arguments filed in Jul. 23, 2003. However, applicants' arguments regarding the objection to the specification under 35 USC 132 and the rejections under 35 USC 112, second paragraph, are not persuasive for the reasons discussed in paragraph 5 above. Accordingly, the rejection stand.

12. Claims 1-4, 7-12, and 14-20 are allowable over the prior art of record, for the reasons discussed in paragraph 4, supra.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

May 17, 2004

*Janis L. Dote*  
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PRIMARY EXAMINER  
GROUP 1500  
1700